In the

Supreme Court of the United States.

OCTOBER TERM, 1946.

No. 297.

RUSSELL BOX COMPANY, PETITIONER,

v.

GRANT PAPER BOX COMPANY, RESPONDENT.

MOTION BY ENSIGN BICKFORD COMPANY TO FILE BRIEF AS AMICUS CURIAE.

May it please the Court:

Ensign Bickford Company, a corporation of Connecticut and doing business at Simsbury, Connecticut, moves for leave, as *amicus curiae,* to file the Brief hereto attached in support of the Petition for Certiorari in the above entitled case.

In support of said Motion, Ensign Bickford Company represents as follows: It is the owner of Letters Patent to Pearsall, No. 1,968,907, on "Composition of Matter", dated August 7, 1934 (R. p. 451). The composition there patented is, in part, amorphous petroleum wax mixed with ester-gum. The decision in the case at bar is of importance to this Company since the Company has granted a license to a manufacturer to use this compound with the right to issue sublicenses to others for laminating paper boxes.

The Pearsall patent mentioned covers a compounded wax which, if used for laminating the walls of paper boxes, is within claim 3 of the patent in suit:

Claim 3. "A container wall for the packaging of material including a sheet or film *composed substantially of an amorphous petroleum wax* of an apparent melting-point of 120°–170° F., carrying a suspended colloid, and two sheets of fibrous material, the sheet or film of said wax intercalated between the sheets of fibrous material and constituting a film of adhesive uniting the whole."[1]

This claim was held valid by the Court of Appeals. The decision of the Court of Appeals therefore prevents the use of the Pearsall compounded wax by box manufacturers who are or may be licensed to use it for lamination, though the Pearsall patent was applied for August 5, 1931, nearly three years prior to the filing of the application for the patent in suit. Ensign Bickford Company accordingly has a direct pecuniary interest of importance.

Furthermore, the public, on expiration of the Pearsall patent will be prevented from using his invention for a particular purpose for some two and one-half years. Such a result is condemned as "counter to the policy and purpose of the patent laws" in the recent decision of this Court in *Scott Paper Co.* v. *Marcalus Co.*, 326 U.S. 249.

Copies of this motion, together with the brief attached hereto, have been submitted to all parties in the case, as provided by Rule 27 (9) of the Rules of this Court. The written consent of the petitioner was obtained, as is indicated below, but the respondent refused to give its consent.

WHEREFORE, Ensign-Bickford Company prays this Honorable Court that its foregoing motion may be allowed and that the brief attached hereto may be filed.

ENSIGN BICKFORD COMPANY,
by its Attorney,
O. WALKER TAYLOR,
31 Milk Street, Boston, Massachusetts.

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[1] Italics ours throughout.

Russell Box Company, petitioner, hereby acknowledges receipt of copy of the foregoing motion and the brief attached thereto, and consents to the filing of brief *amicus curiae* by Ensign-Bickford Company.

By its Attorney,

HERBERT A. BAKER,
53 State Street, Boston, Massachusetts.

BRIEF IN SUPPORT OF ALLOWANCE OF PETITION.

SUMMARY OF ARGUMENT.

The Argument may be summarized as follows:

(1) Claim 3 of the patent in suit is invalid as construed by the Court of Appeals because it is confined to wax having a "*substantial* quantity of resinous colloidal matter". There is no utility in the wax unless there is "a substantial colloidal content" (R. p. 473). It is therefore an indefinite claim and invalid.

There is nothing in the specification or the claim or the finding and rulings of the Court of Appeals which defines any limitation of the claim, although "amorphous wax without at least a substantial colloidal content was unsuitable" for the patentee's purpose (R. p. 473).

(2) The patent, if applied to monopolize manufacture of container walls laminated with waxes containing only natural colloids, gives Dreymann a monopoly on an invention not made by him, but made by a salesman of an oil company.

ARGUMENT.

1. The Court of Appeals erred in validating a claim which does not "inform the public . . . of the limits of the monopoly asserted" and where "the variant . . . is not clearly defined". *General Electric Co.* v. *Wabash Co.*, 304 U.S. 364; *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228.

A. The Court of Appeals found that a "relatively pure amorphous wax" R. p. 470 (*i.e.*, a "wax with only 5 per cent of colloidal content" Pet. for Rehearing, R. p. 479), was not suitable and that "the patent as a whole is not for amorphous petroleum wax in general as a laminating agent for paper, but is only for such a wax for that purpose in combination with a *substantial* quantity of resinous colloidal matter" (R. p. 473).

Both parties in practice use a compound containing 25 per cent resinous colloidal content (R. p. 471). The Court of Appeals found infringement (R. p. 489).

We submit, that where the utility of the invention rests on the use of a "substantial" quantity of colloidal material, and the claim says nothing of the proportions required for utility, it is condemned by the rule of this Court laid down in *General Electric Co.* v. *Wabash Co.*, 304 U.S. 364, 369. There, referring to the words "substantially" and "comparatively large grains", this Court said: "The claim is invalid on its face. It fails to make a disclosure sufficiently definite . . ." (R. p. 368). "The inventor must inform the public during the life of the patent of the limits of the monopoly asserted; so that it may be known which features may safely be used or manufactured without a license and which may not. The claims 'measure the invention'. Patentees may reasonably anticipate that claimed inventions, improvements and discoveries, turning on points so refined as the granular structure of products, require *precise descriptions* of the new characteristic for which protection is sought. In a limited field the variant must be clearly defined".

And the words "substantially pure" among others were condemned as lacking in clarity in *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228, where the Court said: "The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art, and clearly circumscribe what is foreclosed from future enterprise" (p. 236). "An invention must be capable of accurate definition, and it must be accurately defined to be patentable" (p. 237).*

B. The Court of Appeals found that a relatively pure wax having only 5 per cent colloidal content would not do (*supra*, p. 5). Such a wax, however, comes within the claim. No

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* *Cf., Universal Oil Co.* v. *Globe Oil Co.*, 322 U.S. 471–484.

line is drawn by the Court to indicate whether 10 per cent colloidal content would infringe, nor 15 per cent. No new process of lamination is described and *non constat* that a careful and skillful use of known processes using "relatively pure wax" would not produce the container wall desired by the industry. In fact, it appears that 5 per cent ester-gum with 95 per cent crude wax will laminate in the laboratory and produce a satisfactory product (R. p. 240, Qs. 58–64).

The Pearsall patent No. 1,968,907 (R. p. 451), covers a range of proportions from 5 per cent to 95 per cent ester-gum in amorphous petroleum wax. Manifestly, under the Court's decision, the use of the Pearsall compound by licensees under the patent is an infringement if the proportion—20 to 25 per cent ester-gum—is used. Is it an infringement if the proportion of ester-gum is only 5 per cent? Would 10 per cent infringe, or 15 per cent?

Here, then, is the "zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims" condemned by Mr. Justice Jackson in the *United Carbon Case* (p. 236).

We submit that the Supreme Court should grant the petition for certiorari in the case at bar to correct such a far reaching error as may be perpetuated by the decision here criticized.

2. Dreymann is not the discoverer of the use of ordinary commercial wax as a laminating agent, but merely bought a wax suggested by a salesman, and then used it.

Dreymann, the patentee, originally used a commercial wax of 165° F. melting point and that is the wax of his patent (R. p. 132). He found, however, that the wax with a melting point of 155°, used "pure", (Q. 28, R. p. 342) stuck far better and worked successfully (XQ. 179, R. 144). He used the 155° product on the recommendation of a salesman.

Grant, president of the plaintiff respondent, told how the

patentee came to use the 155° melting point product. After his visits to machine companies to get a machine to laminate two sheets of paper together (Q. 25, R. p. 35) and getting a machine in May, 1934, he went with Dreymann to the Socony Vacuum Oil Company in June, 1934 (Q. 29). There he told a sales manager "what we wanted to buy" (Q. 31, p. 35). The salesman said "the wax that we wanted had about a 155 melting point". "I told him (we needed) quite a lot . . . about 600,000 pounds for about a year" (Q. 32, p. 37). Commercial production with this wax was begun in July. No rosin or resin was added in filling orders from July to November, 1934 (XQs. 151, 152, R. pp. 49, 50).

The patent in suit itself implies that the wax of a melting point of 165° is not adequate since it is said (R. p. 360), "The adhesive quality of substances 1 (paraffin) and 2 (paraffin and ester-gum) is practically nil; substance 3 (petroleum wax melting point 165° F.) sticks better. Substances 4, 5, and 6 (wax adulterated with foreign colloids) are adequate for my purpose" (Pat. pp. 2, 11, 27–30, R. p. 360). It is clear that only after the application was filed, Dreymann was told of a satisfactory commercial wax.

Such a solution of a problem by using a commercial product developed by a manufacturer finds an exact parallel in *Collar Company* v. *Van Dusen*, 23 Wallace 530. The patentee there had learned from his experiments that he wanted paper of the qualities described in the patent and after much persistent endeavor such paper was eventually produced by the manufacturer to whom he applied (23 Wall. 562). But he was not the inventor. The Court said ". . . the patentee is not entitled to a patent for the collars as a new manufacture, for several reasons: (1) Because he did not invent either the product or the process by which the product is obtained . . ." Even though the patentee "was the first person to conceive the idea that paper possessing the desired qualities was desirable for the purpose . . ." he was still held not to be the inventor of anything.

Directly opposite to this case, on similar facts, is the finding in this case, where contrary to the *Van Dusen* case the Court of Appeals found invention. Here, the Court said Dreymann "discovered the essential characteristics which a laminating agent for paper ought to have" and "found the agent . . . (a commercially available compound having known characteristics) . . . Nevertheless the value of those characteristics for bonding paper to produce a flexible . . . and moisture vapor proof material . . . was unknown before Dreymann, and therein lies the distinction between the case at bar and the *Sinclair* case"* (R. p. 488).

We submit that respondent is therefore asserting an unjustifiable monopoly and that the Court of Appeals for the First Circuit was wrong in awarding it.

CONCLUSION.

We submit that the Petition for Certiorari should be granted.

ENSIGN BICKFORD COMPANY,
by its Attorney,
O. WALKER TAYLOR.

31 Milk St., Boston, Mass.

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* *Sinclair & Carroll Co., Inc.*, v. *Interchemical Corp.*, 325 U.S. 327.